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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,211	01/03/2005	Marius Petrus Joseph Peeters	14509-0136US1 / P080497BX	5143
26161	7590	10/08/2008	EXAMINER	
FISH & RICHARDSON PC			JACKSON, MONIQUE R	
P.O. BOX 1022			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55440-1022			1794	
NOTIFICATION DATE		DELIVERY MODE		
10/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[PATDOCTC@fr.com](mailto:PATDOCTC@fr.com)

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,211	<b>Applicant(s)</b> PEETERS ET AL.
	<b>Examiner</b> Monique R. Jackson	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 17 June 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08e)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. The amendment filed 6/17/08 has been entered. New claims 10-12 have been added. Claims 1-12 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "the metal nanoparticles form clusters with dimensions of about 1μm with and about 100 nm height" however it is unclear what is meant by the term "of about 1μm with and about 100 nm height".

#### ***Claim Rejections - 35 USC § 102***

4. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(a) as being anticipated by Tomonaga for the reasons recited in the prior office action wherein the Examiner notes that Tomonaga specifically teaches methyl trimethoxysilane which includes an alkoxy group and a methyl group. With respect to Claims 11-12, as recited previously, Tomonaga teaches annealing the coating at elevated temperatures above 350°C including up to 500C°, which would inherently produce the claimed nanoparticle clusters given that the compositions and methods are the same (Abstract; Table 1; Examples.)

5. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Innocenzi for the reasons recited in the prior office action wherein it is noted that Innocenzi

specifically teach **methyltriethoxysilane** which includes an alkoxy group and a methyl group.

With respect to new Claims 11-12 Innocenzi teach annealing at 500°C and given that the compositions and methods are the same, would inherently result in the claimed nanoparticle clusters.

***Double Patenting***

6. Claims 1-9 and new claims 10-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-6 of U.S. Patent No. 7,116,381, for the reasons generally recited in the prior office action, wherein with respect to new Claims 10-12, the patent claims methyltrimethoxysilane and methyltriethoxysilane and one skilled in the art would have been motivated to utilize any conventional annealing temperature above the 250°C claimed in the patent which would naturally result in the claimed clusters.

***Response to Arguments***

7. Applicant's arguments filed 6/17/08 have been fully considered but they are not persuasive. With respect to Tomonaga and Innocenzi, the Applicant argues that the references fail to teach a silane derivative with at least one alkoxy group. However, as noted above, both references teach methyl trialkoxysilanes wherein Tomonaga specifically teaches methyl trimethoxysilane which has a "meth" or 1 carbon atom in the alkoxy moiety, and Innocenzi teaches **methyltriethoxysilane** which has a "eth" or 2 carbon atoms in the alkoxy moiety, wherein both are specifically recited in instant Claim 5 as the silane derivative of the invention.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 10:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Monique R Jackson/  
Primary Examiner, Art Unit 1794  
September 30, 2008